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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,890	03/08/2001	Takashi Yamane	1086.1142	6818

21171 7590 09/08/2005

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,890

Applicant(s)

YAMANE ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-11, 13-16, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15, 16, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 7-11 & 13-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

1. Applicant's amendment received on 5/26/2005 is acknowledged and entered. Applicant has amended claims 1, 7, 15 and 20 and canceled claim 12. Currently claims 1-4, 7-11, 13-16 and 20-21 are pending for examination.

Response to Arguments

2.1. Applicant's arguments filed on 5/26/2005, concerning amended claims 1, 15 and 20, see remarks page 6, have been fully considered but they are not persuasive for following reasons:

The applicant argues that Hughes does not teach initiating an order for both that is a physical good and the downloadable data [as recited in claim 1] and therefore there is no need to set a precedential order time for providing both [recited in claim 2]. The examiner respectfully disagrees. Hughes does teach ordering both that is a physical good including downloadable data (see at least paragraphs 0005, 0020, 0024 and 0034. To quote paragraph 0020:

" The purchasable content preferably includes at least one of downloadable digital data (i.e., digital data capable of being transmitted over the electronic network 10 to the one or more consumers 20) and physical storage media (i.e., a product capable of storing digital data or analog data). It will be appreciated that the downloadable digital data and/or the digital/analog data of the physical storage media may include one or more of audio, video, and text depending on the exigencies of the situation. It is preferred that the audio data is music. Those skilled in the art will appreciate from the disclosure herein that the physical storage media may be optically readable media (e.g., audio discs, video discs, mini-discs, etc.), electrically readable media (e.g., micro-processor readable memories, memory sticks, etc.), magnetically readable media (e.g., cassette tapes, video tapes, etc.), "

Hughes does not limit itself to ordering either the Media OR the digital downloadable data, that is either download or buy the CD. Paragraph 0037 does not recite this limitation but instead it teaches determining the type of the command received , that is if the command is for downloadable data or media. An order, can have several commands denoting selections and

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those commands, altogether, could include both the downloadable data and the media, that is a CD as shown in Figs. 6D and 6E.

As analyzed above Hughes does teach ordering both the downloadable data as well as media the applicant's arguments concerning claim 2 are not persuasive.

2.2. Regarding amended claims 7-11, and 13-14, and claims they are allowable over prior art but are objected to as being dependent upon a rejected base claim, that is claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art of record does not anticipate or render obvious the claimed limitation, that is order receiving step presents to the client connected to the server via a network a providing form set as a default providing form recommended to the client based on providing form analyzing step.

3. **NOTE:** Claim 1 recites the process steps of order receiving and article providing but do not explicitly state that these steps are implemented by the server in connection with the client. The examiner, in view of the applicant's specification and drawings 3-4 assumes that both the process steps of order receiving and article providing are performed by the computerized server connected to the client's web browser using an electronic network and this assumption is part of the prosecution record. If the applicant does not agree with this assumption then he should point out his reasons for difference.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.1. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

4.2. Claims 1-3, 15-16 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes et al. (US Publication 2002/0023015 A1), hereinafter, referred to Hughes.

Regarding claims 1-3, Hughes anticipates an electronic commerce method of a server for performing a commerce with a client by using a network (see Figs. 1 thru 3 which disclose a client-server architecture for conducting electronic commerce using a network [Internet 10] , comprising:

an order receiving step which separates a sales article comprising information and a plurality of goods into information and goods and presents them to the client in a form such that they can be selected; and an article providing step which selects the separated information, the separated goods, or a combination thereof on the basis of an ordering request from said client and provides it to said client (see at least paragraphs 0005, 0020-0049 on pages 1 and 2-6 which disclose the Hughes discloses presenting both downloadable digital data , such as songs [see at least Figs. 6A and 6B] as well as physical storage media , such as CD or

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Cassettes [see at least Figs. 6c and 6d]. The downloadable data corresponds to "separated information" and physical storage media complete with contents, such as CD or Cassette tapes recorded with contents corresponds to "separated goods" as claimed in the instant application. See also all the Figures of Hughes which illustrate the Hughes invention and reads on the limitations of claim 1 of the instant application).

Regarding claims 2 and 3 Hughes discloses that in claim 1, the said article providing step comprises, a time difference service such that after the separated information was precedently provided, the separated goods are provided is executed and in said article providing step, a separation service such that the separated information and the separated goods are respectively solely provided is executed (see at least paragraphs 044-049 on pages 5-6 which disclose that the downloadable data, that is songs can be downloaded while ordering and the separated goods consisting of CD or cassettes are shipped by regular channels, which could be UPS, courier service or USPS and also the execution of the orders is done separately).

Regarding claims 15 and 20, their limitations are closely parallel to the limitations of claim 1 and are therefore analyzed and rejected on the basis of same rationale.

Regarding claims 16 and 21, Hughes discloses further comprising providing form analyzing step which is presented as a default to client (see at least Figs 8C-8E which describes providing a form to obtain client's selection and data required to download information [songs]), the target to be ordered, and registering the user's information [see at least Fig.4, "44 A Registration Module" and Fig. 8A). Note: the limitation, "providing form"

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has been broadly interpreted as the form or format in which the targeted order comprising downloadable information is to be provided.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes and further in view of Dockes et al. (US Patent 6,011,758), hereinafter, referred to as Dockes.

Regarding claim 4, Hughes discloses a method according to claim 1, wherein said sales article is a packaged music recording medium, in said order receiving step, said packaged music recording medium is separated into recorded music piece data, a package, music, and the recording medium itself and presented, and in said article providing step, the packaged music recording medium, the music piece data, the music, the recording medium, or a combination thereof is selected and provided to said client(see at least Figs. 6C and 6D and paragraphs 0038- 0047 on pages 4-5, which disclose that the said sales article "Yield" is a packaged recording medium in a CD or Cassette or Mini Disc, etc. and is packaged from a separated recorded music consists of recorded music piece data, a package, music, and the recording medium and is presented and provided to the buyer).

Hughes does not disclose a medium casing. However, Dockes in the field of same endeavor, that is producing customized CD, discloses a medium casing to be provided with the ordered recording medium(see at least abstract, col. 3, lines 36-40, where the jacket

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corresponds to the medium casing). In view of Dockes, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Hughes to incorporate the feature of including a medium casing as a component to be provided with the CD or recording medium because it enables to cover the recording medium and include description/identification on it relating to the contents of the music.

Allowable Subject Matter

6. Claims 7-11, and 13-14, are allowable over prior art of record but are objected to as being dependent upon a rejected base claim, that is claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Prior art of record does not anticipate or render obvious the claimed limitation, that is order receiving step presents a providing form set as a default providing form recommended to the client based on providing form analyzing step.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PG-Publication 20010025259 to Rouchon discloses a system and method of distributing music/songs to radio station listeners over a public computer network, wherein the listeners are referred to a distribution center "HP website" which tracks the user's preferences, purchases and download of songs and I turn HP website provides this feedback to the radio stations who can tailor their offerings to their listeners preferences (see at least paragraphs 0021-0025 and 0043-0050)

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Yogesh C Garg', with a long horizontal line extending to the right.

Yogesh C Garg
Primary Examiner
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YCG
8/22/2005